REMARKS

In the May 19, 2004 Office Action, the Examiner indicated that claims 3-36 were pending in the application; objected to claims 3-14; rejected claim 20 under the second paragraph of 35 USC § 112 and rejected claims 16-36 under 35 USC § 102(e). In rejecting the claims, U.S. Patent 6,300,947 to Kanevsky (Reference A) was cited. Since the Preliminary Amendment filed September 17, 2001 cancelled claims 3-15 and the Supplemental Preliminary Amendment filed January 31, 2002 cancelled claims 1 and 2 and added claims 16-39, claims 16-39 remain in the case. The Examiner's objections and rejections are traversed below.

The Application

The subject application is directed to modifying web pages to display information on devices having limited display capability, e.g., mobile devices, such as PDAs. This is accomplished by identifying control characters, such as tags in the hypertext mark-up language (HTML) of a web page that might need modification for display on a mobile device (see e.g., paragraphs 13 and 25 of the Substitute Specification).

The Prior Art: U.S. Patent 6,300,947 to Kanevsky

The Kanevsky patent is directed to adapting web pages to a window size on the display screen of a client device. As described at column 6, lines 20-27, a request message 102 (Fig. 1) received from a client device 100 is accompanied with a display mode message 103 defining the display characteristics, such as the height and width (in pixels) of the display screen of the client device. As described at column 8, lines 24-34, this information about the size and characteristics of the user's display is compared in matching module 203 with numeric information extracted from Uniform Resource Locator/Common Gateway Interface (URL/CGI) instructions which are "received from the web site 106" (column 7, line 60). Based on this comparison, one of a plurality of URL/CGI models 201 is selected for converting the web page to be displayed on the client device (see column 8, line 44 to column 9, line 18).

Objection to Claims 3-14

In the first two paragraphs on page 2 of the Office Action, the Examiner objected to claim 3 as dependent from cancelled claims and objected to claims 4-14 under 35 USC § 1.75(c). Furthermore, as noted above, the Examiner indicated that claims 3-36 were pending. However, a Preliminary Amendment was filed on September 17, 2001 upon entering the national phase which cancelled claims 3-15 and a Supplemental Preliminary Amendment was filed January 31,

2002 adding claims 37-39 in addition to canceling claims 1 and 2 and adding claims 16-36. Therefore, claims 16-39 were pending on May 19, 2004 when the Office Action was issued.

Attached hereto are copies of the Preliminary Amendment, Supplemental Preliminary Amendment and the postcard receipts indicating the date of receipt of each by the U.S. Patent and Trademark Office. Withdrawal of the objections to the claims is respectfully requested.

Furthermore, since claims 37-39 were not examined in the first Office Action, it is respectfully submitted that if the claims are not allowed, the next Office Action should not be final as it will contain the first examination of claims 37-39.

Rejection under 35 USC § 112, Second Paragraph

In the last paragraph on page 2 of the Office Action, claim 20 was rejected because "the limitations 'the data server' and 'the mobile computer' ... [had] insufficient antecedent basis ..." The Examiner's attention is directed to lines 5 and 6 of claim 16 which recite "a communication connection between a mobile computer and a data server"; thus, providing the antecedent basis for the terms recited in claim 20 which depends from claim 16. Therefore, withdrawal of the rejection under the second paragraph of 35 USC § 112 is respectfully requested.

Rejection under 35 USC § 102(e)

On pages 3-6 of the Office Action, claims 16-36 were rejected under 35 USC § 102(e) as anticipated by Kanevsky. In making this rejection, it was asserted that the operation of "determining whether predetermined control characters are included in the first data" (e.g., claim 16, line 4) was disclosed at column 8, lines 29-34 of Kanevsky.

First, it is noted that the independent claims recite that a determination is made regarding whether data that is read contains "predetermined control characters" (e.g., claim 16, line 4). On the other hand, the portion of Kanevsky cited as disclosing the first "determining" operation in claim 16 describes comparing "the display parameters from the display mode message to the numeric data received from the interpreter module 202" (column 8, lines 30-32). There is no indication that the comparison described at column 8, lines 29-34 determines whether specific characters are present in the numeric data. Rather, the purpose of the comparison is to determine "whether reconstruction of all of this web page data will fit a display size, given the information contained in the display mode message" (column 8, lines 35-38). This suggests that the comparison involves numerical values, not character matching as recited in the claims.

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Second, the comparison performed by matching module 203 in <u>Kanevsky</u> does not involve anything that is "predetermined" as required by the independent claims. As noted above, the matching module 203 in <u>Kanevsky</u> "compares the display parameters from the display mode message to the numeric data" (column 8, lines 30-31), where "the interpreter module 202 receives the web page data containing the URL/CGI instructions and reads, therefrom, numeric data associated with the URL/CGI textual instructions" (column 7, lines 63-66), while the display mode message accompanies a request message from a client device that contains an "address that defines the route to a file on a server computer on the World Wide Web" (column 6, lines 13-15). Thus, the comparison performed by the matching module 203 in <u>Kanevsky</u> involves dynamic information that at least changes for each device and each web page, while the first determining operation performed in the independent claims involves predetermined characters. This is another way in which the recited operation differs from the comparison performed by the matching module 203 in <u>Kanevsky</u>.

In other words, while both <u>Kanevsky</u> and the present invention are directed to solving similar problems, i.e., displaying web pages on devices of limited capacity, the operations performed to accomplish this task are different. Therefore, it is submitted that claims 16-39 patentably distinguish over <u>Kanevsky</u>.

Request for Examiner Interview

If the rejection of the claims as anticipated by <u>Kanevsky</u> is not withdrawn, it is respectfully requested that the Examiner contact the undersigned by telephone to arrange an Examiner Interview to discuss the differences between the invention and the prior art and what changes, if any, in claim language are necessary to clearly recite these differences.

Amendment of the Substitute Specification

The Substitute Specification has been amended to return text that was inadvertently deleted in paragraph **[0025]**. The English translation of the International Application, which was filed September 17, 2001 (and again December 31, 2001) included text in brackets that was also included in the Marked-Up Copy of the Substitute Specification, but was deleted in creating the Substitute Specification. This Amendment returns the inadvertently deleted text to the specification. No "new matter" has been added, since the text added in this Amendment was included in the English translation.

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Summary

It is submitted that Kanevsky does not teach or suggest the features of the present claimed invention. Thus, it is submitted that claims 16-39 are in a condition suitable for allowance. Reconsideration of the claims and an early Notice of Allowance are earnestly solicited.

Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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